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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/553,731

01/31/2006

Christian Hubschwerlen

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02/19/2010

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EXAMINER

ANDERSON, REBECCA L

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/553,731	Applicant(s) HUBSCHWERLEN ET AL.	
	Examiner REBECCA L. ANDERSON	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-12,14,15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) 6,7 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,11,12,14 and 15 is/are rejected.
- 7) ☒ Claim(s) 1-5,9-12,14 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-7, 9-12, 14, 15 and 17 are currently pending in the instant application. Claims 1-5, 12, 14 and 15 are rejected. Claims 1-5, 9-12, 14 and 15 are objected. Claims 6, 7 and 17 are withdrawn from consideration as being for non-elected subject matter.

Continued Examination Under 37 CFR 1.114

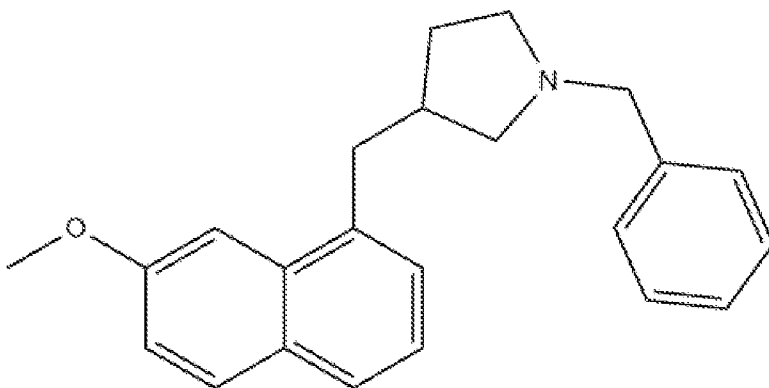
A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11 January 2010 has been entered.

Response to Amendment and Arguments

Applicant's amendment and arguments filed 11 January 2010 have been fully considered.

Applicants' amendment has overcome the 35 USC 102(b) rejection as being anticipated by Greenwood.

As Applicants' have overcome the 35 USC 102(b), according to MPEP 803.02, the examiner has also expanded the search to the species:



1-benzyl-3-[(7-methoxynaphth-1-yl)methyl]pyrrolidine

. The elected embodiment now consists of the compound of example 7 and the above mentioned species, which was not found allowable. Since the elected embodiment was not found allowable, subject matter not embraced by the elected embodiment is therefore withdrawn from further consideration.

It has been determined that the entire scope claimed is not patentable.

As the claims are rejected under 35 USC 102(b), the objection to the claims is maintained as the claims still include subject matter drawn to other than the elected embodiment.

Claim Objections

Claims 1-5, 9-12, 14 and 15 are objected to as containing non-elected subject matter. Claims 1-5, 9-12, 14 and 15 presented drawn solely to the elected embodiment would overcome this objection.

Claim Rejections - 35 USC § 102

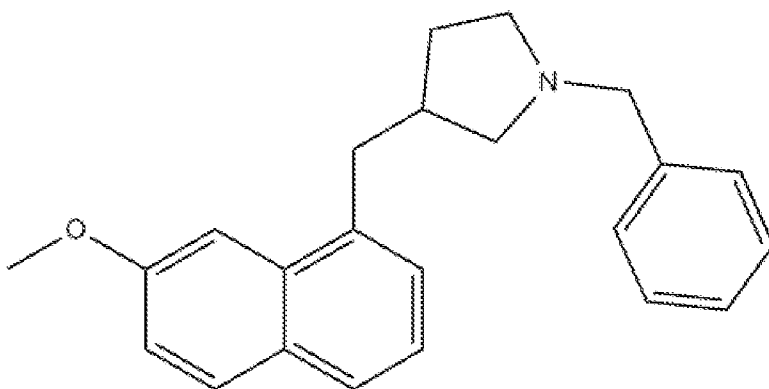
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 12, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,240,942.

US Patent No. 5,240,942 discloses the compound:



1-benzyl-3-[(7-methoxynaphth-1-yl)methyl]pyrrolidine

on columns 19 and 20,

example 29. This compound corresponds to applicants' instant invention wherein R1 is alkyloxy, specifically methoxy; X1-X5 are each CH; A is an alkylene, specifically methylene; n is 0; Cy is a heterocycloalkylene group, specifically pyrrolidine; m is 0; and R3 is B-Y wherein B is an alkylene, specifically methylene and Y is an aryl, specifically phenyl. Pharmaceutical compositions are disclosed on column 27 and 8. The utility for

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the compound are found on column 8, for example, for the treatment of stress, migraines, anxiety, depression, etc.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

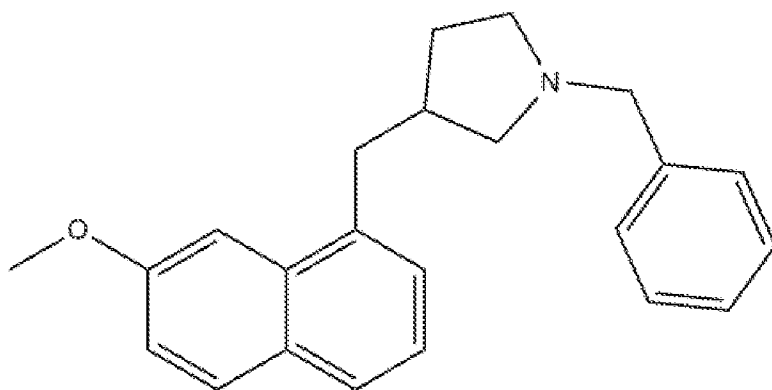
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,240,942.

US Patent No. 5,240,942 discloses the compound:



1-benzyl-3-[(7-methoxynaphth-1-yl)methyl]pyrrolidine

on columns 19 and 20,

example 29. This compound corresponds to applicants' instant invention wherein R1 is alkyloxy, specifically methoxy; X1-X5 are each CH; n is 0; Cy is a heterocycloalkylene group, specifically pyrrolidine; m is 0; and R3 is B-Y wherein B is an alkylene, specifically methylene and Y is an aryl, specifically phenyl. Pharmaceutical compositions are disclosed on column 27 and 8. The utility for the compound are found on column 8, for example, for the treatment of stress, migraines, anxiety, depression, etc.

The difference between the claimed invention and the compound of example 29 is the position equivalent to A. In the instant claim 11 A-(CH₂)_n- has a chain length of 2 or 3 atoms, whereas in the prior art compound of example 29 A is an alkylene, specifically methylene.

However, minus a showing of unobvious results, it would have been obvious to one of ordinary skill in the art when faced with the prior art of US Patent No. 5,240,942,

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to prepare compounds as in applicants' instant claim 11 as to those skilled in chemical art, one homologue is not such an advance over adjacent member of series as requires invention because chemists knowing properties of one member of series would in general know what to expect in adjacent members. In re Henze, 85 USPQ 261 (1950). The instant claimed compounds would have been obvious because one skilled in the art would have been motivated to prepare homologs of the compounds taught in the reference with the expectation of obtaining compounds which could be for the treatment of stress, migraines, anxiety and depression. Therefore, the instant claimed compounds would have been suggested to one skilled in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/
Primary Examiner, AU 1626*

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Technology Center 1600

12 February 2010